

Docket No. 200314661-1

MAR 12 2007

Remarks

This Amendment is responsive to the December 12, 2006 Office Action. Reexamination and reconsideration of claims 1-29 is respectfully requested.

Summary of The Office Action

Claims 2-10 were allowed.

Claims 12-13, 21-22 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 24-25 were rejected under 35 U.S.C. §101 because the claimed invention is purportedly directed to non-statutory subject matter.

Claims 11, 15-20 and 23-29 were rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McIntyre et al. (6,229,538).

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35 U.S.C. §101 Rejection

Claims 24-25 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Office Action relies upon and cites MPEP 2106.01.

Claim 24 recites “A computer-readable medium storing processor executable instructions operable to perform a method, the method comprising...” This is a standard Beauregard claim that has been ruled to be statutory subject matter. *In re Beauregard*, 35 USPQ2d 1383 (Fed. Cir. 1995). MPEP 2106.01, which is relied upon by the Examiner, also states that this claim type is statutory.

MPEP 2106.01, second paragraph, states:

“When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” (MPEP 2106.01, second paragraph)

MPEP 2106.01, first paragraph defines “functional descriptive material” as “data structures and computer programs which impart functionality when employed as a computer component.” Claim 24 expressly recites “processor executable instructions.” Thus, claim 24 is statutory subject matter based on the MPEP rules. The rejection is thus improper and should be withdrawn.

Additionally, the rejection is based on interpreting the claimed “computer-readable medium storing processor executable instructions” to be limited to a specific example from a number of embodiments listed in paragraph [0017] of the specification. The definition of computer-readable medium is one that is well understood by one of ordinary skill in the computer arts. Applicant points out that the selected embodiments used to form the rejection (e.g. transmission media) are not expressly recited in the claims. As such, the Examiner is importing limitations from the specification into the claims and is improper based on MPEP 2111.01(II).

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MPEP 2111.01(II) states that is improper to import claim limitations from the specification:

"Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). [Emphasis added]

Claim 24 expressly recites "computer-readable medium storing processor executable instructions." Besides being a per se statutory Beauregard claim and statutory under MPEP 2106.01, the ordinary meaning of this claim type is broader than the particular embodiments used in forming the rejection. Thus, the rejection is reading a particular embodiment appearing in the written description into the claim when the claim language is broader than the embodiment. This is prohibited by MPEP 2111.01(II) and the rejection is improper and cannot stand.

Applicant respectfully points to MPEP 2106.01 section VII that states the Office Action should clearly communicate the findings, conclusions and reasons which support them. Thus, the general citation to the entire Interim Guidelines and MPEP 2106.01 fails to establish a proper §101 rejection and the rejection should be withdrawn (Office Action, page 3).

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The Claims Patentably Distinguish Over the References of Record

Claims 11, 15-20 and 23-29 were rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McIntyre et al. (6,229,538).

Independent Claim 11

Claim 11 recites a method for controlling a port, comprising programmatically setting a mode control signal that identifies whether a port is to be in a powered mode or a non-powered mode, and if the mode control signal indicates the non-powered mode, disconnecting power to the port and configuring the port to process data signals. Applicant submits that McIntyre fails to teach or suggest these features.

The Office Action cites McIntyre figure 13, column 13, lines 1-34 and column 16, lines 3-42 as teaching the recited "disconnecting power to the port and configuring the port to process data signals." Applicant submits that McIntyre discusses enabling and disabling power to a slot but when power is disabled, the slot is turned off and thus does not function. McIntyre represents a disabled power state with a "cable break" icon, which would be understood by one of ordinary skill in the art as no signals are processed. McIntyre states:

"A powered off graphic icon 1318 illustrates an installed NIC in which the slot is powered off. The ability to separately enable or disable power to any slot, such as any of the slots S1-S4 of the computer system 100, enables replacement or otherwise hot-plugging of the slot with another controller, if desired. The powered off graphic icon 1318 includes a cable break graphic icon 1320 ..." (McIntyre, column 16, lines 29-35) [Emphasis added]

Thus, McIntyre fails to teach or suggest "disconnecting power to the port and configuring the port to process data signals" as recited in claim 11. When McIntyre disables power, the port no longer processes data signals. Therefore, McIntyre fails to teach or suggest claim 11 and the rejection should be withdrawn. Claim 11 should now be allowed.

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Independent Claim 17

Claim 17 has been amended to recite that in response to the non-powered mode, the port code controller disconnects power to the port and causes the circuit to provide the signal processing function to the port. This language is similar to the language of claim 11 thus no new matter has been added.

In view of the explanation above concerning McIntyre, McIntyre fails to teach or suggest a controller that disconnects power to the port and causes the circuit to provide the signal processing function to the port. Rather, McIntyre teaches that when power is disabled from a slot, it no longer functions and thus does not provide a signal processing function. (McIntyre, column 16, lines 29-35). Therefore, McIntyre fails to teach or suggest claim 17 and the rejection should be withdrawn. Claim 17 should now be allowed.

Independent Claim 24

Claim 24 has been amended to recite processor executable instructions that in response to the port mode option being a non-powered mode, causing the logic to disconnect power to the port while allowing the port to communicate data signals. As explained previously, McIntyre fails to teach or suggest allowing the port to communicate data signal when it disables power. Rather when power is disabled, the slot of McIntyre is turned off and no longer functions. (McIntyre, column 16, lines 29-35). This is represented by the "cable break" icon 1320 used by McIntyre (see Figure 13). Therefore, McIntyre fails to teach or suggest claim 24 and the rejection should be withdrawn. Claim 24 should now be allowed.

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Independent Claim 26

Claim 26 recites a mode controller means for configuring the port between a powered mode and a non-powered mode, where in the non-powered mode, power is removed from the port and the port continues to communicate signals. As explained previously, McIntyre teaches that when power is disabled, the slot of McIntyre is turned off and no longer communicates signals. (McIntyre, column 16, lines 29-35; cable break icon 1320). McIntyre thus fails to teach or suggest any element that removes power from the port and the port continues to communicate signals as recited in claim 26.

Therefore, McIntyre fails to teach or suggest claim 26 and the rejection should be withdrawn. Claim 26 should now be allowed.

Independent Claim 29

Claim 29 has been amended to recite that where in the non-powered mode, the configuring includes removing power from the port and allowing the port to communicate data signals. McIntyre teaches that when power is disabled, the slot of McIntyre is turned off and no longer communicates signals. (McIntyre, column 16, lines 29-35; cable break icon 1320). McIntyre thus fails to teach or suggest claim 29 and the rejection should be withdrawn. Claim 29 should now be allowed.

Accordingly since all independent claims patentably distinguish over McIntyre and are in condition for allowance, all dependent claims also patentably distinguish over McIntyre.

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Conclusion

For the reasons set forth above, claims 2-13 and 15-29 patentably and unobviously distinguish over the references and are allowable. An early allowance of all claims is earnestly solicited.

Respectfully submitted,



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